

REMARKS

Status of the claims:

With the above amendment, claim 1 has been amended and claim 6 has been canceled. Claims 1, 3-5, and 8-13 are pending and ready for further action on the merits. No new matter has been added by way of the above amendments. Claim 1 has been amended by incorporation of the subject matter of claim 6. Reconsideration is respectfully requested in light of the following remarks.

Improper Finality

Applicant does not believe that the Examiner has established a valid basis on which to make the Office Action final. Applicant's amendments did not necessitate the new ground(s) for rejection. Because the amendments made to the claims in the last response (filed August 8, 2003) were not significant, Applicant believes that the Examiner could have rejected the claims prior to the most recent Office Action using EP 0 902 322 A1. Thus, Applicant does not believe that the amendments necessitated the new rejection and Applicant believes that the finality of the Office Action is in error. Accordingly, should the instant response not lead to a Notice of Allowance, Applicant respectfully requests withdrawal of the finality of the Office Action mailed October 23, 2003.

Rejections under 35 USC §§102/103

Claims 1, 3-6, and 8-13 are rejected under 35 USC §102(a) as being anticipated by, or alternatively, under 35 USC §103(a) as being unpatentable over EP '322 (EP 0 902 322 A1).

This rejection is traversed for the following reasons.

Present Invention

The present invention, as recited in claim 1, relates to a thermally processed image forming material having a support, which comprises a first side and a second side, wherein:

the first side has an image forming layer and an outermost layer containing a binder and the second side has an outermost layer containing a binder which is different from the binder of the outermost layer on the first side,

the binder contained in the outermost layer on the first side and the binder contained in the outermost layer on the second side have a common monomer of less than 75 wt%, and

the outermost layer on the first side contains a polymer latex in an amount of 50 wt% or more of the total binder contained in the outermost layer on the first side or the outermost layer on the second side contains a polymer latex in an amount of 50 wt% or more of the total binder contained in the outermost layer on the second side,

wherein a ratio of a Vickers hardness of the binder contained in the outermost layer on the first side and a Vickers hardness of the binder contained in the outermost layer on the second side is within a range from 0.1 to 0.95, or within a range from 1.05 to 10.

Disclosure of EP '322

EP '322 discloses a thermographic image-recording element comprising an image-forming layer and a protective layer on one side of a support, and optionally a back layer on the opposite side of the support. A polymer latex is used as a binder in each of the image-forming layer, the protective layer, and the back layer. The element experiences a minimized dimensional change before and after heat development. No wrinkling is said to occur upon heat development.

Removal of the Rejection over EP '322

First, Applicant respectfully points out that EP '322 makes no mention of Vickers Hardness. Applicant points out that not only does EP '322 fail to mention Vickers Hardness, EP '322 also fails to state a relationship between the outermost layer on the first side and the outermost layer on the second side. Thus, the Examiner has not shown all the elements of instantly amended claim 1. Accordingly, an anticipatory rejection over EP '322 is

inapposite. Withdrawal of the rejection under 35 USC §102 is warranted and respectfully requested.

Regarding the 35 USC §103(a) rejection over EP '322, this rejection is also traversed. Attached to this response, please find a 37 CFR §1.132 declaration executed by Mr. Kubo, the inventor of the instant invention. In this declaration, Mr. Kubo tested the closest example in EP '322 (*i.e.*, Sample No. 2) against the instant claimed invention and evaluated the Vickers Hardness. Sample No. 2 was prepared as appears in EP '322.

The results of the experiment indicate that Sample No. 2 of EP '322 is outside of the claimed range for Vickers Hardness as recited in claim 1 of the instant invention. The other samples that represent the invention of EP '322 have the same outermost layers on both sides as does Sample No. 2. Thus, none of the samples of EP '322 fall within the scope of the instantly claimed invention.

Accordingly Applicant asserts that the Examiner has failed to make out a *prima facie* case of obviousness with regard to the 35 USC §103(a) rejection over EP '322. Three criteria must be met to make out a *prima facie* case of obviousness.

- 1) There must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.

- 2) There must be a reasonable expectation of success.
- 3) The prior art reference (or references when combined) must teach or suggest all the claim limitations.

See MPEP §2142 and *In re Vaeck*, 20 USPQ2d 1438 (Fed. Cir. 1991).

In particular, the Examiner has failed to meet the third element to make a *prima facie* obviousness rejection. EP '322 fails to disclose or suggest the Vickers Hardness as claimed in the instant invention. For this reason alone, the rejection is inapposite. Withdrawal of the rejection is warranted and respectfully requested.

Moreover, even if a proper *prima facie* case were made, which Applicant does not concede, the instant invention possesses unexpectedly superior results relative to the disclosure of EP '322. In particular, the instant invention has superior results in terms of adhesiveness because the Vickers Hardness is adjusted on both sides of the support.

Further, Mr. Kubo also prepared a modified Sample No. 2 and evaluated the adhesiveness of Sample No. 2 and Modified Sample No. 2 as described in the declaration. Modified Sample No. 2 does not include Snowtex C in its protective layer of the back side in order to adjust the ratio of Vickers hardness in order to satisfy the instantly claimed conditions. The results of these experiments indicate that Sample No. 2 (which has a ratio of Vickers Hardness outside of the claimed range) is not of

practical use, while Modified Sample No. 2 (wherein the Vickers Hardness is in the claimed range) is proper for practical use. These advantageous effects are shown in Table 4 of the instant written description.

One of ordinary skill in the art would never be able to achieve the effects of the instant invention from the disclosure of EP '322 because EP '322 not only fails to disclose anything regarding Vickers Hardness, EP '322 also fails to recognize the instantly claimed relationship between the outside layer on the first side and the outside layer on the second side.

Thus, for the above reasons, Applicant submits that the rejection over EP '322 has been obviated. Withdrawal of the rejection is warranted and respectfully requested.

With the above remarks and amendments, Applicant believes that the claims, as they now stand, define patentable subject matter such that passage of the instant invention to allowance is warranted. A Notice to that effect is earnestly solicited.

If any questions remain regarding the above matters, please contact Applicant's representative, T. Benjamin Schroeder (Reg. No. 50,990), in the Washington metropolitan area at the phone number listed below.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

By 
Marc S. Weiner, #32,181

BS
MSW/TBS/mua

P.O. Box 747
Falls Church, VA 22040-0747
(703) 205-8000

Attachment: Declaration under 37 CFR § 1.132